

## REMARKS

Applicants' invention relates to a method of protecting technical materials by applying a composition comprising from about  $10^{-6}$  to 30 parts by weight of 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine (i.e., imidacloprid) and from about 0.01 to about 90 parts by weight of  $\pm\alpha$ -[2-(4-chlorophenyl ethyl)- $\alpha$ -(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol (i.e., tebuconazole).

### Amendments to Claims 19 and 20

During a phone interview on November 8, 2002, the Examiner kindly pointed out that Applicants' previous Amendment dated September 6, 2002, had failed to change the general terms "insecticide" and "fungicide" to the more specific names used in the amended antecedent claims. Applicants have therefore amended Claims 19 and 20 to correct this inadvertent oversight. Claims 19 and 20 remain fully supported in the specification.

### Rejection under 103

Claims 7, 9, 10, 14, and 19-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,742,060 ("Shiokawa et al"); *The Pesticide Manual*, 9th edition, ed. C.R. Worthing (Surrey, UK: British Crop Protection Council, 1991), pages 785 and 831-834 ("Worthing"); and EP 148,526 ("Van Dyck et al") for the same reasons set forth in the previous Office Action. Applicants respectfully traverse.

It is well established that for an applicant's invention to be obvious in view of a combination of references, something in the art taken as a whole, other than the applicant's disclosure, must suggest the applicant's claimed invention. See *In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1532 (Fed. Cir. 1988); *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The incentive to combine references must come from the cited references, from knowledge of those skilled in the art that the references are relevant in a particular field, or from the nature of the problem to be solved. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996). Although the test for obviousness does not require a bodily incorporation of the features of a secondary reference into the primary reference (cf.

*In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (CCPA 1981)), "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-1317 (Fed. Cir. 2000) (emphasis added); see also *Ecolochem v. Southern California Edison*, 227 F.3d 1361, 56 U.S.P.Q.2d 1065, 1073, 1075-1076 (Fed. Cir. 2000), and *Pro-Mold*, 37 U.S.P.Q.2d at 1630. "Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components in the manner claimed." *In re Kotzab*, 55 U.S.P.Q.2d at 1316 (emphasis added); see also *Ecolochem*, 56 U.S.P.Q.2d at 1076. Failure to follow these precepts risks "fall[ing] victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." 55 U.S.P.Q.2d at page 1316.

Furthermore, it has long been recognized that even structurally similar inventions can be patentably distinct under certain circumstances. E.g., *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966). For example, a narrowly claimed invention is not rendered obvious merely because a reference discloses "compounds having a generic formula which would include [the claimed compounds] if proper selection from among the many possible variables were made as suitable for the claimed purpose," particularly where "the shotgun type approach of the reference . . . would not guide one skilled in the art to choose [applicants'] restricted class of compounds from among the host of possible combinations and permutations suggested by patentees." *Ex parte Strobel and Catino*, 160 U.S.P.Q. 352 (P.O. Bd. App. 1968) (emphasis added); see also *In re Baird*, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994). This principle is particularly applicable where the reference teaches a preference for compositions other than those claimed in the new application. E.g., *Ex parte Strobel*, 160 U.S.P.Q. at 352-353; see also *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1987), and *In re Creson*, 177 U.S.P.Q. 264, 266-267 (C.C.P.A. 1973).

Applicants maintain that the cited documents fail to satisfy these established requirements for showing obviousness.

**Shiokawa et al** discloses compounds having a formula that encompasses within its broad scope 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine (i.e., imidacloprid), the first component of the composition used in Applicants' claimed method. Shiokawa et al does specifically disclose this compound – under the name 1-(2-chloro-5-pyridylmethyl)-2-(nitroimino)imidazolidine – at column 12, lines 32-33, but only as one of a multitude of compounds in an extensive list at columns 11-12 and by its formula in Example 11-ii (column 58, line 35) but again only as one of a vast array of compounds described in the Examples at columns 54 to 202.

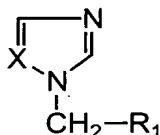
As pointed out in Applicants' Amendment dated September 6, 2002, the only reference in Shiokawa et al to additional active components is found in a very general statement at column 53, line 61, through column 54, line 2, which identifies such compounds only as "insecticides, baits, sterilizing agents, acaricides, nematocides, fungicides, growth-regulating substances or herbicides" and further defines insecticides only to the extent of identifying "phosphates, carbamates, carboxylates, chlorinated hydrocarbons, phenylureas, substances produced by microorganisms." Nowhere does Shiokawa et al disclose tebuconazole, by name or formula. Nowhere does Shiokawa et al even remotely suggest a combination of imidacloprid and tebuconazole, much less disclose a combination of imidacloprid and tebuconazole having the specific relative amounts specify by Applicants.

Shiokawa et al therefore provides no motivation to make and use the extremely narrowly defined combination specified by Applicants.

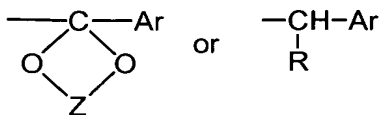
As pointed out in Applicants' previous Amendment, **Worthing** does disclose tebuconazole as stated in the previous Office Action. Worthing also discloses formulations containing tebuconazole in combination with triadimefon, carbendazim, and triadimenol, but all four of these compounds are fungicides. Worthing et al does not teach combinations of tebuconazole with any other active ingredients or types of active ingredients.

Worthing therefore provides not motivation to combine tebuconazole with insecticides, much less with the specific compound imidacloprid at specific relative amounts.

As pointed out in Applicants' previous Amendment, **Van Dyck et al** discloses wood preserving agents containing specific azoles having the formula



in which X is N or CH and R<sub>1</sub> is



where Ar is optionally substituted phenyl or other aromatic groups and R can be any of a variety of groups. E.g., page 3, line 14, through page 4, line 7. Van Dyck et al also teaches combinations of the disclosed azoles with insecticidal agents. See page 7, lines 20-29.

However, tebuconazole – although itself a triazole fungicide – does not fall within the scope of the compounds disclosed in Van Dyck et al, and imidacloprid is not even mentioned by class in Van Dyck et al.

Applicants fail to understand how a reference that does not mention either of the components of their claimed invention, much less suggest their specified relative amounts of the two components, can have any relevance whatsoever to Applicants' claimed invention.

The Office Action itself admits that the particular combination of compounds specified by Applicants is not disclosed in the cited references. Applicants, in fact, submit that the cited references, whether taken separately or taken together, would not have led those skilled in the art to the combination of components specified by Applicants.

Applicants also note, particularly with respect to the applicability of Worthing and Van Dyck et al, that the previous Office Action stated, in support for a restriction requirement, that "[t]he specific elected invention of the combination supra is clearly

patentable [sic] distinct from another different and non-elected combination" and that "[t]he multitude of different combinations are non-related to each other, have different fields of search and can support different patents." See Office Action dated June 26, 2002, at page 2. Applicants submit that references that fail to describe the components or combinations of components they specify cannot lead those skilled in the art to their claimed invention.

Applicants therefore maintain that their claimed invention is not rendered obvious by Shiokawa et al, Worthing, and Van Dyck et al.

#### Rejection under 102

Claims 7, 9, 10, 14, and 19-21 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,972,971 ("Heuer et al"). Applicants respectfully traverse.

Applicants first point out that Heuer et al is not properly citable as a reference under 35 U.S.C. 102. Heuer et al issued on October 26, 1999, and has a "§ 371" date and a "§ 102(e)" date of December 15, 1995. Applicants' application, on the other hand, is a divisional of a continuation of an application that was first filed in the United States on April 22, 1992 (for which Applicants have properly claimed priority) and that itself properly claims ultimate priority based on two Japanese applications filed April 27, 1991 and December 12, 1991. See Filing Receipt (mailed July 24, 2001) for the present application.

However, even if Heuer et al were available as a reference, Applicants maintain that Heuer et al lacks the specificity to anticipate their claimed invention.

Heuer et al discloses wood preservative combinations containing hexaconazole and/or metconazole and further known compounds. E.g., column 1, lines 6-13. Although the specification focuses throughout on combinations of hexaconazole and synergistically acting insecticides and optional fungicides (e.g., column 1, lines 34-55, as well as column 1, line 56, through column 6, line 6, and column 8, line 56, through column 9, line 26), Claim 1 of Heuer et al does not refer to hexaconazole but is instead directed to combinations of metconazole and imidacloprid (see column 9, lines 32-40). [Specific reference to hexaconazole appears only in Claims 3 and 4.] Moreover, Heuer et al clearly lacks any suggestion

that a combination of imidacloprid and tebuconazole will provide the advantages the reference describes. Although the general disclosure of Heuer et al does refer to tebuconazole (e.g., column 1, lines 65-67, and column 2, line 9) and to imidacloprid (e.g., column 2, lines 54-56, and column 3, line 30), these compounds are disclosed only as isolated members of a multitude of possible additional components that can be used in combination with hexaconazole. Only Claim 3 teaches that tebuconazole and imidacloprid can be used together but even then only in a three-part composition that must always contain metconazole.

Applicants submit that Heuer et al lacks the specificity to teach or even suggest the narrowly defined combination of tebuconazole and imidacloprid, or for that matter the specific relative amounts, that they specify and therefore respectfully submit that Heuer et al could not anticipate their claimed invention even if available as a reference.

#### Obviousness-type Double Patenting


Claims 7, 9, 10, 14, and 19-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-5 of Heuer et al. Applicants respectfully traverse.

For the reasons discussed above, Applicants submit that Heuer et al would not have suggested to those skilled in the art the narrowly defined combination of tebuconazole and imidacloprid that characterize their claims. In fact, Claims 1-5 of Heuer et al are directed only to three-component combinations of tebuconazole, imidacloprid, and metconazole.

Applicants therefore respectfully submit that their claimed invention is patentably distinct from Heuer et al and that a terminal disclaimer is not needed to overcome the rejection.

In view of the preceding amendments and remarks, allowance of the claims is respectfully requested.

Respectfully submitted,

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## ANNOTATED VERSION OF AMENDMENTS

### IN THE CLAIMS:

Claims 19 and 20 have been amended as follows:

19. (thrice amended) The method of Claims 7 or 14, wherein the composition comprises from about 0.0005 to 15 parts by weight of the [insecticide] 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine and from about 0.05 to about 50 parts by weight of the [fungicide]  $\pm\alpha$ [2-(4-chlorophenyl ethyl)- $\alpha$ -(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol].

20. (thrice amended) The method of Claims 7 or 14, wherein the composition comprises from about 0.005 to 2 parts by weight of the [insecticide] 1-(6-chloro-3-pyridylmethyl)-2-nitroimino-imidazolidine and from about 0.1 to about 30 parts by weight of the [fungicide]  $\pm\alpha$ [2-(4-chlorophenyl ethyl)- $\alpha$ -(1,1-dimethylethyl)-1H-1,2,4-triazole-1-ethanol].